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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,760	01/04/2002	Anthony A. Sauve	96700/725	6299

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EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT PAPER NUMBER

1623

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/038,760

Applicant(s)

SAUVE ET AL.

Examiner

Traviss C. McIntosh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10, 11, 14, 15, 30 and 33-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4, 10, 11, 14, 15, 30, 33-39, 41 and 42 is/are rejected.  
7) ☒ Claim(s) 5 and 40 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Amendment filed March 4, 2005 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 1-3 and 34-37 have been amended.

Claims 38-42 have been added

Claims 6-9, 12-13, 16-29, and 31-32 are canceled.

Remarks drawn to rejections of Office Action mailed December 1, 2004 include:

112 2<sup>nd</sup> paragraph rejections: which have been overcome in part by applicant's amendments and have been withdrawn in part.

102(b) rejection: which has been overcome by applicant's amendments and have been withdrawn.

An action on the merits of claims 1-5, 10-11, 14-15, 30, and 33-42 is contained herein below.

The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

### ***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant situation, claim 2 intends to limit A to various N-

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linked moieties, however, in the restriction requirement set forth on 7/23/2004, the examiner set forth three groups which were N-linked, O-linked, and S-linked groups. Applicants then elected group I, drawn to N-linked compounds and canceled the claims drawn to the specific O-linked and S-linked compounds. As such, the portion of claim 1 which is drawn to the non-elected inventions, i.e. O-linked and S-linked molecules, has not been considered and therefore, claim 2 is not seen to be further limiting.

Applicant is advised that should claim 10 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, because claim 2 is not seen to be further limiting to claim 1, as set forth supra, claim 11 is seen to be a duplicate to claim 10, as they are identical claims wherein claim 10 depends from claim 1 and claim 11 depends from claim 2.

Applicant is advised that should claim 14 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, because claim 2 is not seen to be further limiting to claim 1, as set forth supra, claim 15 is seen to be a duplicate to claim 14, as they are identical claims wherein claim 14 depends from claim 1 and claim 15 depends from claim 2.

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Applicant is advised that should claim 34 be found allowable, claim 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, because claims 10 and 11 are seen to be substantial duplicates, as set forth supra, claim 35 is also seen to be a duplicate of claim 34, as they are identical claims wherein claim 34 depends from claim 10 and claim 35 depends from claim 11.

Applicant is advised that should claim 36 be found allowable, claim 37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, because claim 2 is not seen to be further limiting to claim 1, as set forth supra, claim 37 is seen to be a duplicate to claim 36, as they are identical claims wherein claim 36 depends from claim 1 and claim 37 depends from claim 2.

Applicant is advised that should claim 41 be found allowable, claim 42 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, because claims 10 and 11 are seen to be substantial duplicates, as set forth supra, claim 42 is also seen to

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be a duplicate of claim 41, as they are identical claims wherein claim 41 depends from claim 10 and claim 42 depends from claim 11.

### ***Double Patenting***

Claims 1-4, 10-11, 14-15, 30, 33-39, and 41-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7, 10-14, 17-19, 21-22, 29-31, and 34-35 of copending Application No. 10/158,636. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications comprise claims which are overlapping in scope and are claiming the same species. Claim 1 of the instant application and claim 1 of the '636 application both comprise the same core structure with the same moieties in the B, C, and D positions. It is noted that the A positions additionally overlap wherein the instant application provides that A is optionally an N-linked substituted pyridyl group, and the claim does not define what is intended to be substituted where, and the '636 application comprises various moieties which are seen to be N-linked substituted pyridyl groups. As such, both applications are drawn to various N-linked pyridyl moieties which are substituted, see moieties (i) and (ii) of the '636 application for example. Therefore, the genus of both applications overlap in the species that are claimed and the two applications are seen to be obvious over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

Claims 1-3, 10-11, 14-15, 30, 33-38, and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 1 for being drawn to compounds which are optionally “N-linked **substituted** pyridyl groups” at the moiety A is maintained for reasons of record. It is noted that claims 2 and 3 also comprise this limitation. In the absence of the identity of moieties which are intended to be substituted, thus modifying an art recognized chemical core, described structurally or by chemical name, the identity of “substituted” would be difficult to ascertain. In the absence of said moieties, the claims containing the term “substituted” are not described sufficiently to distinctly point out that which applicant intends as the invention.

Applicants argue that the term “substituted” does not render the instant claims indefinite since one of skill in the art would be able to understand the difference between substituted and unsubstituted groups. However, it is not enough that someone understands the difference between a substituted pyridyl group and an unsubstituted pyridyl group, it is that one of skill in the art would not be able to know the metes and bounds of the instant claims. There is nothing defining what is to be substituted, where it is to be substituted, and how many moieties can be substituted therein. Applicants state that pages 7 and 8 of the specification provide examples of substituents that may be included on the various groups. However, it is noted that if applicant’s are relying on their specification for a definition, the specification must clearly set forth the definition explicitly and with reasonably clarity, deliberateness, and precision. See *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); *Rexnord Corp. v.*

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*Laitram Corp.*, 60 USPQ2d 1851, 1854 (*Fed. Cir. 2001*); and MPEP 2111.01. In the instant case, there is not seen to be a clear and concise definition for what is intended by “substituted” moieties, but rather an exemplary definition, and exemplification is not an explicit definition.

All claims which depend from an indefinite claim are also indefinite. *Ex parte Cordova*, 10 U.S.P.Q. 2d 1949, 1952 (*P.T.O. Bd. App. 1989*).

### ***Conclusion***

Claims 5 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

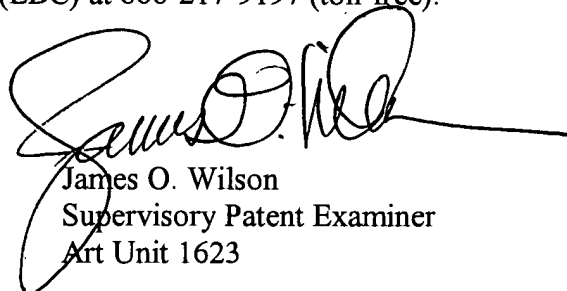
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Traviss C. McIntosh III  
May 26, 2005



James O. Wilson  
Supervisory Patent Examiner  
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